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In re Application of :  
Joel Tucciarone et al. : Examiner Retta, Yehdega  
Serial No. 09/750,923 : Art Unit 3622  
Filed: January 2, 2001 :  
For Electronic Messaging System & Method Thereof

April 6, 2006

APPEAL BRIEF UNDER 35 USC 134(a) & 37 CFR §41.37

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Honorable Secretary of Commerce for Intellectual Property  
United States Patent and Trademark Office  
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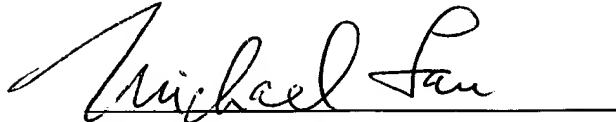
Dear Secretary of Commerce for Intellectual Property:

This is an appeal brief appealing the final decision of the Office Action mailed on August 17, 2005. A Notice of Appeal accompanied with the requisite fees has already been filed on February 13, 2006. Concurrently filed herewith by way of a Credit Card Payment Form is the Appeal Brief submission fee in accordance to 37 CFR 41.20(b)(2) for a small entity.

This Appeal Brief being timely filed on or before the due date, entry of this Appeal Brief is respectfully requested. Should there be an oversight regarding the due date, an appropriate petition for extension of time is respectfully requested.

The Secretary of Commerce in Intellectual Property is hereby authorized to charge any underpayment of fees or credit any overpayment of fees in connection with this communication to Deposit Account 502840.

Respectfully submitted,

A handwritten signature in cursive script, reading "Michael Lau", written in black ink. The signature is positioned above a horizontal line.

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**(1) Real Party in Interest**

The real party in interest is Zoe Corporation with a mailing address of:

Zoe Corporation  
C/O RMI  
125 Maiden Lane, 16th Floor  
New York, NY 10039  
USA

**(2) Related Appeals and Interferences**

There are no other pending related appeals, interferences or judicial proceedings known to the appellant, the applicant's legal representative, or assignee which may be related to, directly affect or be directly affected by or having a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

Pending claims 1, 4-53 and 65-75 are all finally rejected by the Office Action dated August 17, 2005 and the Advisory action dated February 6, 2006.

Claims 54-64 are withdrawn from consideration by the Office due to a restriction requirement.

No pending claims are allowed.

No pending claims are being objected to.

**(4) Status of Amendments**

The Applicants appeal the final rejection of the Office Action mailed on August 17, 2005. An After-Final Amendment has been filed on November 15, 2005 but it was not entered by the Examiner. In the Advisory Action mailed on February 6, 2006, the Office has stated that the After-Final Amendment will be entered for purposes of appeal and an explanation of how the new or amended claims in the After-Final Amendment would be rejected is provided in the Advisory Action. Assuming the After-Final Amendment is entered by the time this Appeal Brief reaches the Board, this Appeal Brief is drafted as if the After-Final Amendment is already entered as promised in the Advisory Action.

**(5) Summary of Claimed Subject Matter**

The invention can be understood by corresponding the recited claimed language with the drawings and explanations in the specification. A citation provided hereinbelow merely indicates by way of an example a place of support in the specification. There may be other places of support in the specification. The indicated example should not be construed as the metes and bounds of the claims. The metes and bounds of the claims should only be construed by the invention as disclosed in the patent application as a whole.

1. (Amended) A marketing method of requesting and collecting promotional information (i.e. such words as advertise, advertiser, advertisement, etc. appear in the written specification for no less than 50 times) to influence an individual's purchasing decisions from a network via an information account of a system with a processor and a memory (i.e. page 6, line 6 to page 11, line 24), comprising a plurality of steps of:

making a request (i.e. Figure 4, reference number 914) by indicating to the information account a type of information desired (i.e. Fig. 4, reference numeral 974);

entering a duration in which the request is active (i.e. Figure 4, reference numerals 980, 982, 984);

collecting in the information account (i.e. Figure 4, reference numeral 928) a result obtained from the network in response to the request, within the duration;

storing in the memory both the request and the result (i.e. Fig. 10).

2-3. (Canceled)

4. (Amended) The method of claim [1] 75, further comprising a step of:

determining an amount of result in the record (i.e. Fig.4, reference numeral 979).

5. (Amended) The method of claim [1] 75, wherein a utility analyzes behaviors of a requester making the request in view of the record (i.e. Figure 10, reference numeral 1020, page 11, lines 9-20, the paragraph bridging between pages 29 and 30 of the written specification).

6. (Original) The method of claim 1, further comprising a step of:

determining an actual duration the request stayed active (i.e. page 9, line 18 of the written specification).

7. (Original) The method of claim 1, further comprising a step of:

taking an action based on the result obtained from the network in response to the request (i.e. Figure 10, reference 1020).



8. (Original) The method of claim 7, further comprising a step of:

categorizing the action taken after receipt of the results (i.e. Figure 10, reference 1020, page 11, lines 7-20).

9. (Original) The method of claim 7, wherein the action is one of made a purchase, not made a purchase, continued to make the request, modified the request, purchased within a time range and abandoned the request (i.e. claims as originally filed, the paragraph bridging between pages 10 and 11, pages 5-6 of Figure 15).

10. (Amended) The method of claim 1, further comprising a step of:

inputting information associated with one of various levels of readiness to buy and a purchase intentionality index (i.e. page 18 of Figure 15, page 4 of Figure 16).

11. (Amended) The method of claim 1, further comprising a step of:

entering information associated with one of a usage intentionality index (i.e. claims as originally filed, page 5 of Figure 15).

12. (Original) The method of claim 11, further comprising a step of:

determining whether to issue one of an electronic refund and a coupon voucher based on one of the purchase intentionality status, the purchase intentionality index and the usage intentionality index (i.e. claims as originally filed, page 18 of Figure 15, page 26 of Figure 16).

13. (Original) The method of claim 1, further comprising a step of:

specifying one of a destination and a plurality of destinations regarding where a result of the request is to be delivered to (ie, claims as originally filed, Figure 5b, reference numerals 879, 826-845).

14. (Original) The method of claim 1, wherein an origin of where the request is initiated from is insulated from the network (i.e. claims as originally filed, pages 4 and 15 of Figure 15, page 22 of Figure 16).

15. (Original) The method of claim 1, wherein the request comprises a plurality of request parameters (i.e. page 51, lines 9-13 of the written specification).

16. (Original) The method of claim 1, wherein the duration is preset for one of a future activation date and a future cut-off date (i.e. claims as originally filed).

17. (Original) The method of claim 1, further comprising a step of:

specifying a time the request is made known to the network (i.e. claims as originally filed, Figure 10).

18. (Original) The method of claim 1, further comprising a step of:

entering a quantity of information desired as expressed in one of a fixed number and a range (i.e. claims as originally filed, Figure 4, reference numeral 979).

19. (Original) The method of claim 1, further comprising a step of:

entering a preferred method of transmission as expressed in a transmission rate (i.e. claims as originally filed, the

paragraph bridging between page 24 and 25 of the written specification, pages 1 and 12 of Figure 16).

20. (Original) The method of claim 1, further comprising a step of:

entering a preferred method of transmission suitable for a particular type of receiving terminus (i.e. claims as originally filed, the paragraph bridging between page 24 and 25 of the written specification, pages 1 and 12 of Figure 16).

21. (Original) The method of claim 1, further comprising a step of:

entering a geographic region where the type of information is to be collected from (i.e. claims as originally filed, the paragraph bridging between pages 44 and 45).

22. (Original) The method of claim 1, further comprising a step of:

specifying a certain promotional type which the type of information is to be collected from (i.e. claims as originally filed, page 12, lines 5-13 of the written specification, page 3 of Figure 15).

23. (Original) The method of claim 1, further comprising a step of:

specifying a source of origin where the type of information is to be collected from (i.e. claims as originally filed, the paragraph bridging between pages 44 and 45 of the written specification).

24. (Original) The method of claim 1, further comprising a step of:

specifying the type of information must be collected from a source accepting a certain transaction method (i.e. claims as originally filed).

25. (Original) The method of claim 1, further comprising a step of:

entering a delivery priority of the type of information based on a plurality of terminus (i.e. claims as originally filed, pages 3-4, 9, 12 of Figure 16).

26. (Original) The method of claim 15, further comprising a step of:

ranking a plurality of results based on how close each result matches the plurality of request parameters (i.e. claims as originally filed, pages 4 and 12 of Figure 16).

27. (Original) The method of claim 15, further comprising a step of:

entering a priority of delivery based on how well a plurality of results matches the specified request parameters (i.e. claims as originally filed, page 3-4 of Figure 15, pages 12 and 17 of Figure 16).

28. (Original) The method of claim 1, further comprising a step of:

specifying a time the type of information should be delivered to the information account (i.e. claims as originally filed, page 17 of Figure 15).

29. (Original) The method of claim 1, further comprising a step of:

specifying a repetitive pattern the type of information should be delivered to the information account (i.e. claims as originally filed, pages 3 and 17 of Figure 15).

30. (Original) The method of claim 1, wherein the account comprises an electronic mail (email) account, an instant messaging account, a wireless short messaging account, a wireless account, a cellular telephone account, a paging account, a facsimile number, a voice mailbox, a bulletin board, an addressable TV terminus address, a posting address and a print out address (i.e. claim as originally filed, pages 1 and 4 of Figure 15).

31. (Original) The method of claim 1, wherein the type of information is indicated by one of selecting from an index with a mouse, entering from a keyboard and entering orally with a microphone (i.e. claims as originally filed).

32. (Original) The method of claim 1, wherein the type of information is searched from one of a public domain resource and a private domain resource (i.e. claims as originally filed).

33. (Original) The method of claim 1, wherein the duration is measured in one of seconds, minutes, hours, days, weeks, months, years, and a combination thereof (i.e. claims as originally filed, page 12, lines 5-13 of the written specification.)

34. (Original) The method of claim 1, further comprising a step of:

entering an update interval of the request (i.e. claims as originally filed, the paragraph bridging between pages 40 and 41 and the paragraph bridging between pages 44 and 45 of the written specification).

35. (Original) The method of claim 34, wherein the update interval is measured in one of seconds, minutes, hours, days, weeks, months, years, and a combination thereof (claims as originally filed).

36. (Original) The method of claim 1, further comprising a step of:

specifying a format of a result (i.e. claims as originally filed, page 41, line 14 to page 42, line 9 of the written specification).

37. (Original) The method of claim 36, wherein the format comprises HTML/PIX, Video, Audio, Text, ASCII, TIFF, JPEG and other formats used in the digital transmission of data (i.e. claims as originally filed, page 41, line 14 to page 42, line 9 of the written specification).



38. (Original) The method of claim 1, further comprising a step of:

specifying whether a related subject of the type of information is desired (i.e. claims as originally filed, page 14, line 13 of the written specification).

39. (Previously Amended) The method of claim 1, further comprising a step of:

specifying whether a search should be conducted in one of a public domain resource, a private domain resource, and a combination thereof (i.e. claims as originally filed).

40. (Original) The method of claim 39, further comprising a step of:

taking payment information from a requester via one of a micro-payment system, billing or credit card system (i.e. claims as originally filed, the paragraph bridging between pages 10 and 11 of the written specification).

41. (Original) The method of claim 1, further comprising a step of:

receiving a result of the requested type of information in the account in a specified format at a specified update interval within the duration the request is active, in a quantity desired and according to a priority and a preference (i.e. claims as originally filed).

42. (Original) The method of claim 1, wherein the method is implemented on one of an instant messaging utility, a wireless messaging utility (WAP or other), an electronic mail utility, a paging utility, a facsimile utility, a voice mail utility, a bulletin board utility, a printer utility, a browser utility, a cable utility, a satellite utility, a digital broadcast utility, a television system utility, a web-TV utility and an Internet utility (i.e. claims as originally filed).

43. (Original) The method of claim 1, wherein the request is transmitted via one of a 2-way addressable television system, or a hybrid system where download is via a broadband signal and upload is via telephone, a cable system, an Internet system, an Intranet system, a satellite system, a Web-TV system and a digital broadcast system, a local area network and a wide area network (i.e. claims as originally filed).

44. (Original) The method of claim 1, wherein the method is implemented on a computer system in one of an always active mode and a launched upon request mode (i.e. claims as originally filed, the paragraph bridging between pages 44 and 45 of the written specification).

45. (Original) The method of claim 1, wherein the method is integrated as a request utility as part of one of a web site and a portal (i.e. claims as originally filed, the paragraph bridging between pages 24 and 25 of the written specification).

46. (Original) The method of claim 1, wherein a requester's identity is concealed from an origin providing a result relevant to the request (i.e. claims as originally filed, page 4 of Figure 15).

47. (Original) The method of claim 1, further comprising a step of:

designating automatic forwarding of requested informational/advertising e-mails to one of a single party, a plurality of parties, an existing carbon copy (cc) list, and a newly created distribution list of e-mail recipients (i.e.

claims as originally filed, page 9, lines 15-23 of the written specification).

48. (Original) The method of claim 1, further comprising a step of:

paying for a result relevant to the request by one of a micro-payment, billing, and credit card system (i.e. claims as originally filed, the paragraph bridging pages 10-11 of the written specification).

49. (Original) The method of claim 1, wherein the system captures a requester behavior with respect to a result delivered to the requester (i.e. claims as originally filed, pages 5-7 of Figure 15).

50. (Original) The method of claim 49, wherein the requester behavior comprises opening the result, saving the result, deleting the result, forwarding the result, responding to the result, making a purchase transaction via email in response to the result, registering for any offer in response to the result and archiving the result (i.e. claims as originally filed, page 5, 8 and 14 of Figure 16).

51. (Original) The method of claim 1, wherein should the request fail to specify any preferences or request criteria, default preferences or request criteria are imposed by the system (i.e. claims as originally filed, the paragraph bridging between pages 40 and 42 of the written specification).

52. (Original) The method of claim 51, wherein the default preferences or request criteria are based on one of an average preferences or request criteria of the account in the type of information, an average preferences or request criteria of the overall account, an average preferences or request criteria of the system in the type of information, and an average preferences or request criteria of the overall system (i.e. claims as originally filed, the paragraph bridging between pages 40 and 42 of the written specification).

53. (Original) The method of claim 1, wherein a result of the request can only reach the account with one of a digital key, a certificate for permitted access and a password recognized by a lookup table (i.e. claims as originally filed, pages 1, 11 and 16 of Figure 15).

54-64. (Withdrawn).

65. (previously presented) The method of claim 1, wherein the requesting and collecting of information is performed by being one of a trusted intermediary and a third party (i.e. page 16, lines 9-21 of the written specification).

66. (previously presented) The method of claim 65, wherein a feature of one of the trusted intermediary and third party is achieved by having the processor and the memory to hold a lookup table (i.e. claim 53 as originally filed).

67. (previously presented) The method of claim 65, wherein a feature of one of the trusted intermediary and third party is achieved by a channelized address (i.e. pages 2 and 6 of Figure 16).

68. (previously presented) The method of claim 65, wherein a feature of the trusted intermediary and the third party is achieved by a limited used cryptographic system.

69 (amended) The method of claim 65, wherein a feature of one of the trusted intermediary and the third party is achieved by a

traditional email alias account wherein the aliases are deleted from the account once a predetermined time has expired.

70. (previously presented) The method of claim 65, wherein a feature of one of the trusted intermediary and the third party is achieved by storing a computer table in a relational database (i.e. pages 1, 11 and 16 of Figure 15).

71. (previously presented) The method of claim 66, wherein the lookup table is held by a bonded party to insulate a seeking party and a providing party from knowing each other (i.e. Originally filed claim 14, page 16, lines 9-21).

72. (previously presented) The method of claim 65, wherein a feature of one of the trusted intermediary and the third party is achieved by insulating a purchasing party and a selling party from knowing each other after consummation of a sales transaction (i.e. Claim 14, pages 16, lines 9-21).

73. (New) A method of requesting and collecting information from a network via an information account of a system with a processor and a memory, comprising a plurality of steps of:

making a request by indicating to the information account a type of information desired;

entering a duration in which the request is active;

inputting an information indicative of a level of readiness to buy;

collecting in the information account a result obtained from the network in response to the request, within the duration;

storing in the memory both the request and the result (claims 1 and 10).

74. (New) A method of requesting and collecting information from a network via an information account of a system with a processor and a memory, comprising a plurality of steps of:

making a request by indicating to the information account a type of information desired;

entering a duration in which the request is active;

inputting an information indicative of a purchase intentionality;

collecting in the information account a result obtained from the network in response to the request, within the duration;



storing in the memory both the request and the result  
(claims 1 and 10).

75. (New) The method of claim 1, further comprising a step of:  
maintaining a record to capture the request and a result  
obtained from the network in response to the request (originally  
filed claim 3).

**(6) Grounds of Rejection to be Reviewed on Appeal**

**Group I: Rejection under 35 USC §102(e), Anticipation**

Whether claims 1, 4-53 and 65-75 are anticipated under 35  
U.S.C. §102(e) by Murphy et al. (U.S. Patent Application No.  
6,298,307).

**Group II: Rejection under 35 USC §103(a), Obviousness**

Whether claim 12 is unpatentable under 35 U.S.C. §103(a)  
based on Murphy et al. further in view of Chern et al. (U.S.  
Patent No. 6,381,465).

**(7) Argument**

On the outset, it is the Applicants' understanding that in  
asserting a rejection, the Office is materially representing

that 1) a best prior art reference has been applied; and 2) the merit of that best prior art reference supports a legal conclusion of unpatentability. It is against this understanding that the Applicants would like to challenge the final Office rejection, because the applied prior art of record simply does not disclose or teach the claimed invention on the merit. This shortcoming of the Office position will become apparent in view of the following explanations.

**Group I: Rejection Under 35 USC §102(e), Anticipation**

Whether claims 1, 4-53 and 65-72 are anticipated under 35 U.S.C. §102(e) by Murphy et al. (U.S. Patent Application No. 6,298,307).

Independent claim 1 had been amended to recite:

"1. A marketing method of requesting and collecting promotional information to influence an individual's purchasing decisions from a network via an information account of a system with a processor and a memory, comprising a plurality of steps of:  
making a request by indicating to the information account a type of information desired;  
entering a duration in which the request is active;  
collecting in the information account a result obtained from the network in response to the request, within the duration;  
storing in the memory both the request and the result."

In response to the Applicant's amendment to independent claim 1, the Office in an Advisory Action mailed on February 6, 2006 stated in relevant part that:

"Applicant, by amending the preamble of the independent claims, asserts that the claim now clearly states that the present invention is a marketing method as distinguished from a time varying weather predicting method of Murphy. Applicant amended the preamble to indicate requesting and collecting promotional information to influence an individual's purchasing decisions, however, in the body of the claim recites the step of making a request by indicating to the information account a type of information desired. There nothing in the claim that indicates the request to the information account is a promotional information. The preamble is treated as intended use only."

Therefore, an official determination regarding the preamble is clearly communicated. Namely, it is "treated as intended use only". It is safe to conclude that by communicating to the Applicants that the preamble is treated as intended use only, the Office is also communicating to the Applicants by implication that no patentable weight has been given to the preamble during the examination process.

The Office has frankly and clearly stated that the rationale of its position is due to the fact that "nothing in the claim that indicates the request to the information account is a promotional information." Should this be the predominate reason, Applicant wonders whether it is the position of the Office that if the adjective "promotional" is inserted in the

body of the claim immediately prior to "information" so that it is clear that a user is requesting promotional information, then patentable weight would be given to the preamble. If so, it should be noted that there is not such a rudimentary requirement imposed by either statutory law or common law as a pre-requisite to give patentable weight to the preamble. Should the Office know of any statutory law or common law imposing such a rudimentary requirement, Applicants would welcome a citation of such laws.

To the contrary, it is the understanding of the Applicant that the context in which the preamble can be understood along with the body of the claim in their totality is determinative whether patentable weight should be given. In this regard, the Federal Circuit has clearly stated in relevant part that "a claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Corp.*, 55 F.3d, 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). Therefore, the preamble should not be ignored or considered in isolation. Rather, the preamble should be considered with the body of the claim as a whole. By ignoring and giving no patentable weight to selective part of the preamble, the Office is not considering the preamble and the body of the claim as a whole, which consideration is required by *Bell*.

In another case, the Federal Circuit has stated in relevant part that "if the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999).

Applying this decision to the instant claim, first, as the preamble states "a marketing method of requesting and collecting promotional information to influence an individual's purchasing decisions" and as the body of the claim states "making a request by indicating to the information account a type of information desired" and "collecting in the information account a result obtained from the network in response to the request", it is clear that the claim preamble, when read in the context of the entire claim, indeed recites limitations of "promotional information" and "to influence an individual's purchasing decisions" to the claim. For these reasons, the claim preamble should be construed as if it is in the balance of the claim.

Second, "promotional information to influence an individual's purchasing decision" of the preamble certainly give life, meaning and vitality as to what type of information being

requested, collected and stored in the body of the claim, and ultimately give the very vital purpose and real life application of why promotional information is being requested, collected and stored. Therefore, given the life, meaning, and vitality the preamble adds to the body of the claim, the preamble should be construed as if it is in the balance of the claim.

Yet in another case, the issue is whether any patentable weight should be given to a clause in the preamble stating "a human in need thereof." The Federal Circuit stated that "in considering the effect of the preamble in a claim directed to a method of treating or preventing pernicious anemia in humans by administering a certain vitamin preparation to "a human in need thereof," the court held that the claims' recitation of a patient or a human "in need" gives life and meaning to the preamble's statement of purpose." *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003).

In this case, the court has clearly stated that a preamble's statement of purpose should not simply be ignored. Rather, proper consideration should be given to evaluate whether other aspects of the claim would give life and meaning to the preamble's statement of purpose.

Applying this case to the instant application, the very active step that the individual has taken to request and collect information at all is for the purpose of obtaining promotional information that would influence the individual's purchasing decisions, as clearly stated in the preamble. It is clear that the steps of requesting, collecting and storing in the specific steps of the claim indeed give life and meaning to the preamble's statement of purpose. Therefore, patentable weight should have been given to the preamble.

Even the predecessor court of the Federal Circuit, the Court of Claims and Patent Appeals has stated that a preamble reciting "[a]n abrasive article" was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated "it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable *inter alia* of use as abrasive grains and a binder is not an 'abrasive article.'" Therefore, the preamble served to further define the structure of the article produced.

Applying this case to the present invention, the term "promotional information" should be deemed essential to point out the invention defined by claims to a marketing method

comprising making a request by indicating to the information account a type of information desired, and all subsequent steps taken to collect and store the information. It is only by that term that it can be known that the subject matter defined by the claims is comprised as a promotional information. Every recitation of information in the body of the claim is not a "promotional information." Therefore, the preamble served to further define "information" recited in various steps of the method claim.

Lastly, even if the preamble merely communicates a statement of purpose of use, which it does not as clearly discussed, *supra*, by applying the facts of this application to numerous controlling case laws, the Federal Circuit has explicitly stated that:

"[t]he determination of whether preamble recitations are structural limitations or mere statements of purpose of use 'can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.' *Corning Glass Works*, 868 F.2d at 1257. The inquiry involves examination of the entire patent record to determine what invention the patentee intended to define and protect." *Rowe v. Dror*, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997).

The Federal Circuit has basically stated that what is patentable does include what the patentee intends to protect. Just because the preamble contains statements that communicates



what the inventor intends to protect, the statements cannot automatically be classified as under intended use, thus deemed irrelevant for the purpose of determining patentability. The Federal Circuit by making such a decision, to the fullest extent necessary, overrides any prior inconsistent decisions made by its predecessor courts and any other inferior courts. By making such a decision, the Federal Circuit clearly dictates that the Board of Patent Appeals and Interferences and the Examining Corp. to make patentability determination to be consistent with this case.

It is respectfully submitted that the Office in making its current decision, has not given any consideration to the decisions of the Federal Circuit as stated in *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) and *Rowe v. Dror*, 42 USPQ2d 1550 (Fed. Cir. 1997). Because the Office has not given any patentable weight to the synergistic effects acting in concert between the preamble and the body of the claim, the Office has failed to review the entire patent application "to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Corning Glass Works*, 868 F.2d at 1257. Therefore, the Office has also failed to conduct a full inquiry to examine "the entire patent record to determine what invention the patentee

intended to define and protect." *Rowe v. Dror*, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997).

In every one of these court cases, there is clear authoritative directive that the preamble of the present invention should have been accorded patentable weight for reasons given above. Had the Office given proper patentable weight to the preamble, it would be undisputed that the present invention is a marketing method, as distinguished from a time varying weather predicting method of Murphy. Also, it would also be undisputed that the type of information is clearly stated as promotional information for the purpose of influencing an individual's purchasing decisions, as distinguished from a weather related information as stated in Murphy. Thus, by correctly according patentable weight to the preamble alone, it would be sufficient to show that independent claim 1 is patentably distinguished over Murphy. All claims depending thereon, by virtue of inherency, are also patentably distinguished over Murphy.

In the Advisory Action, the Office has also stated in relevant part that:

"Applicant argues that there is no indication of any allowable subject matter and features that are not identified by the Office as having been disclosed or taught in the asserted prior art should be regarded as patentable subject matter. Examiner disagrees with Applicant's assertion. Examiner did not indicate

allowance subject matter since the Examiner could not find any allowance matter to indicate. Examiner provided the columns and paragraph lines where the prior art provides the teaching. Applicant, if he could not find the teachings in the indicated part of the disclosure, need to state the features that are not taught by the prior art."

The Office has raised several interesting issues in making these statements. With regard to the statement that "Examiner provided the columns and paragraph lines where the prior art provides the teaching", indeed the Office has provided several columns and paragraph lines of Murphy. Specifically, in the final Office action, regarding the anticipation rejection under 35 U.S.C. 102(e) based on Murphy, the final Office action stated in its entirety that:

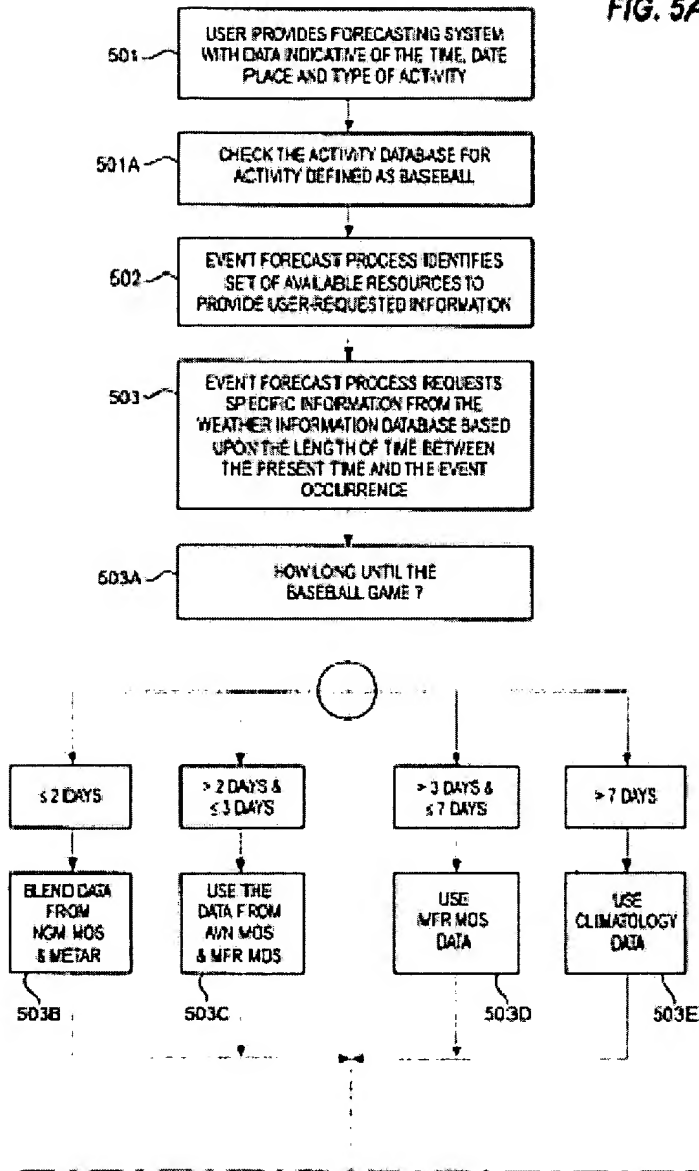
"Regarding claims 1, 4-53 and 65-72, Murphy teaches making a request indicating a type of information; entering duration; receiving the information; a record to capture the request and result; analyzing the behavior of the requester; determining actual duration; taking an action based on the result (fig. 5B (505, 506) ... determining the amount of the result in the record (see col. 10 lines 41-54); Murphy teaches user preference database to record past activity of the user; action is one of made a purchase, not a purchase etc., (see col. 1 line 62 to col. 2 line 61, col. 3 line 40 to col. 4 line 41, col. 7 line 63 to col. 9 line 11 and col. 10 line 55 to col. 11 line 18, Fig. 5A). Murphy teaches collecting a result obtained from the network (see fig. 5B (504) and storing the request and the result (see fig. 5A & 5B, col. 10 line 55 col. 11 line 18). Murphy teaches the collecting done by other than the user requesting the information (third party)."

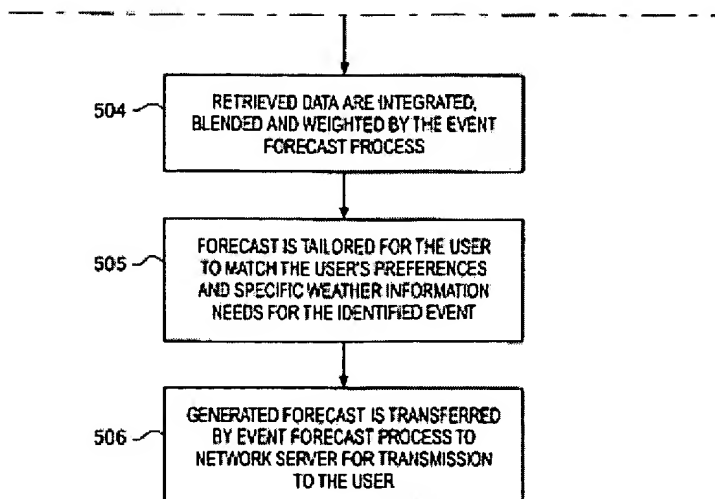
It should be pointed out that in rejecting claims 1, 4-53 and 65-72, a total of 57 claims, which occupy approximately 15 typed pages, the Office action finally rejected all 57 claims in one single paragraph occupying merely 10 typed lines on page 4 of the final Office action mailed on August 17, 2005. This certainly reflects the level of thorough examination and attention the instant application received from the Office. This should also reflect the shot-gun nature of the rejection and overwhelming majority of the features in the 57 claims have never been addressed by the Office at all.

Regarding claims 1, 4-53 and 65-72, the Office action merely stated that "Murphy teaches making a request indicating a type of information; entering duration; receiving the information; a record to capture the request and result; analyzing the behavior of the requester; determining actual duration; taking an action based on the result" citing Fig. 5B reference numerals 505 & 506 of Murphy; and "determining the amount of the result in the record" citing column 10 lines 41-54 of Murphy.

The meaning of Figure 5B can only be determined in the context of Figure 5A. Naturally, these figures should be considered in tandem. Figures 5A and 5B in their entirety are shown hereinbelow:

FIG. 5A





**FIG. 5B**

Details pertaining to Figures 5A and 5B are discussed from column 7, line 63 to column 10 line 54, stating in its entirety that:

"FIGS. 5A and 5B illustrate in flow diagram form the processing of a user provided forecast request by the present best-in-time forecasting system 100. A user provides the best-in-time forecasting system 100 with data indicative of the time, date, place and type of activity at step 501. Regardless of the information provided by the user, the best-in-time forecasting system 100 generates a response with the thoroughness and accuracy of the response being a function of the specificity of the user-provided information and the length of time between the present time and the event occurrence. In particular, the user's request stimulates the best-in-time forecasting system 100 at step 501A to check the Activity Database 413 to determine the particular characteristics that are relevant to the selected activity. The Event Forecast Process 401 at step 502 identifies the set of resources that are available to the best-in-time

forecasting system 100 that can be used to provide the user-requested information. The information can be purely climate data or a blending of real-time and forecast data sources. The forecast can also be tailored to the specific activity identified by the user. The user-provided data can include threshold data which causes the best-in-time forecasting system 100 to generate a notification of the user if certain parameters are met or exceeded. The best-in-time forecasting system 100 can then notify the user through some communication medium, such as by Network Server 402 transmitting an E-Mail message to the user over network 403. The request may alternatively originate via user's calendar and scheduling software, project management software, an events scheduler or by completing a system provided screen.

A user requests a forecast for a particular date, time and place. Based upon the length of time between the present time and the event occurrence, at step 503 the Event Forecast Process 401 requests specific information from the Weather Information Database 102. The retrieved data are integrated, blended and weighted by the Event Forecast Process 401 at step 504 to produce the best possible forecast from the presently available information. The forecast is tailored for the user to match the user's preferences and specific weather information needs for the identified event at step 505. Finally, the generated forecast is transferred by Event Forecast Process 401 to Network Server 402 for transmission to the user at step 506 over Network 403.

Example: A user is planning a trip to a selected city at a point in time distant from the present time. The user's event scheduling system is set to alert the user if precipitation is predicted for the event. The users event scheduling system can periodically query the best-in-time forecasting system 100 to provide the user with the desired information. As the event date and time approaches the presently time, the specificity and accuracy of the forecast increases.

In this query process example, the user, identified by the user code ID71466, requests the forecast for the desired event, comprising a baseball game being played

at 10 AM tomorrow in Boston, Mass. at Fenway Park. This request is made over the Internet to Network Server 402. In the present example, this request comprises the data: baseball game, Boston, 10 AM tomorrow. This request is sent by the user from their data input terminal over the network 403 to the web server (Network Server 402). The user request can be coded in the following exemplary form:

```
/event?userID=71466&rq_type=baseball&station=BOS&date=08%2F07%2F97& dtime=10&name=Toronto+at+Boston
```

In the best-in-time forecasting system 100, the selection of data sources is done based upon the following factors:

1. The geographic location for which a forecast is desired.
2. The length of time between the time of the request and the time for which a forecast is desired.
3. The type of activity for which the forecast is intended.

The decisions made by the Event Forecast Process 401 of the best-in-time forecasting system 100 to select the appropriate data sources to produce a forecast for a baseball game are shown in FIG. 5 as:

How long until the baseball game? (Step 503A)

If less than two days, then blend data from NGM MOS & METAR (Step 503B)

If between two days and three days, use the data from AVN MOS & MFR MOS (Step 503C).

If between three days and seven days, use MFR MOS data (Step 503D).

If more than seven days, use climatology data (Step 503E).

In addition to the selection of the type of data, the Activity Database 413 defines that if the Event



Forecast Process 401 is forecasting for a baseball game that is scheduled to occur in less than two days, then provide a time specific forecast for the first inning (defined as a point in time with respect to the scheduled beginning of the event) and another time specific forecast for the nominal end of the event (ninth inning--estimated to be three hours after the scheduled beginning of the event). The Activity Database 413 also identifies to the Event Forecast Process 401 that the variables that are important to a typical individual attending the selected event are: temperature, wind speed and direction, relative humidity, cloudiness, chance of precipitation, and heat index or wind chill. The Activity Database 413 also defines the format of the data to be presented to the user, such as wind direction should be characterized in terms of its orientation with the facility in which the event takes place. Thus, instead of an absolute measure of North at 5 mph, the present best-in-time forecasting system 100 presents the data in relative terms such as "out of left field at 5 mph". The orientation of the facility is also stored in the Activity Database 413.

In the present example, the two data sources that are selected are the most appropriate given the above criteria. Other data sources that only give a high and low for the day, such as the NWS MRF model, or the AN model do not contain enough information to forecast for a specific hour of the day. There are other sources, which can contribute to a more accurate forecast, and the inclusion of specific sources in the present best-in-time forecasting system represents a matter of design choice. The data used in this example is obtained from the well known weather sources of National Weather Service Family of Services: METAR Surface Data, and NGM MOS Data.

Both data sets are assimilated into a form that can be readily placed into the Data Store 302 contained in the Weather Information Server 102. New METAR data does not always completely outdate previously received METAR data and the newly received data must therefore be merged with the previously received data. NGM MOS data is similar in that the newly received data does not always completely outdate previously received NGM

MOS data. The newly received data from both of these sources are assimilated into a single record in the Data Store 302. The system also interpolates the NGM MOS data from 3 hour intervals, as received, into 1 hour intervals. This data receipt, assimilation and interpolation occur on a continuous basis as data is available to ensure that the data stored in the Data Store 302 is always current.

The Event Forecaster Process 401 determines that the request for the forecast is less than 48 hours from the time of the event. Based upon this information, the Event Forecaster Process 401 at step 503B requests the latest METAR data for the Boston site. The Event Forecaster Process 401 blends the two sets of data by comparing the actual observation data in the Boston METAR report with the forecasted information for Boston as noted in the NGNB MOS report. The Event Forecaster Process 401 calculates a difference between each variable in the two reports for which a forecast is requested and calculates a correction factor (CF) based upon the amount of time between the time of the last METAR report and the time for which the Event Forecast Process 401 is forecasting, which is termed time "T". The Event Forecaster Process 401 applies the full correction  $CF=1$  if  $T=3$ , otherwise,  $CF=e^{-a(T-3)}$ , where  $a$  is a constant that determines the rate at which the amount of correction decreases over time. The Event Forecaster Process 401 then adds the calculated correction to the NGM MOS forecast values for the time that the Event Forecast Process 401 is forecasting for.

For the present example:

1. The present METAR data indicates that the Boston temperature at 7 PM is 67 degrees.
2. The NGM MOS forecast indicates that the temperature for Boston at 7 PM was 74 degrees.
3. The temperature difference is -7 degrees ( $T_{diff} = -7$ ).

4. From the NGM MOS forecast indicates that the forecasted temperature for 10 AM tomorrow is 77 degrees (T.sub.ngm).
5. The difference between the last known time 7 PM and the time at which we are forecasting is 15 hours.
6. The following formula, where  $a=0.77016353$  is used to compute the correction factor  $CF=e^{sup.-a(15-3)}$  =0.397.
7. The amount of correction is then given by  $T.sub.corr = CF * T.sub.diff = -2.78$ .
8. The new temperature forecast  $T.sub.new = T.sub.ngm + T.sub.corr = 74$ .

A temperature forecast of 74 degrees is then provided at step 506 to the requesting user for a temperature forecast for Boston valid at 10 AM tomorrow. The process assimilates information from different sources about a single location to provide a more accurate forecast than any one by themselves could provide. The event based forecast process is capable of making decisions based upon the data sources that are available and provide some information for any location it knows about for any date and time in the future.

Similar calculations are performed for the wind, precipitation probability for the beginning of the game, then the process is repeated for the time representative of the end of the game. The user ID is also used to retrieved data from the User Preferences Database 412 that identifies the format of the content that is returned to the user. For example, the requesting user can be connected over a high bandwidth communication connection and the Event Forecast Process 401 can then present the information to the user in a graphically intensive display. Similarly, the user can desire only a subset of the normally presented information, and this "filter factor" can be recorded in the User Preferences Database 412 as a result of prior user activity."

From carefully reading the explanations given regarding Figures 5A and 5B of Murphy, it is clear that Murphy is a weather forecasting system. Upon a user request, the forecasting system would provide weather predictive information in the near future. The user armed with supposedly ever more accurate weather information as the target date approaches may decide whether to attend a certain function. It is clear that Murphy is not a marketing method of requesting and collecting promotional information to influence an individual's purchasing decisions. Naturally, Murphy never disclosed the majority of the claimed features associated with the marketing method.

Regarding further features associated with features recited in claim 1 but are not disclosed in Murphy, these features are specifically listed in claims 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45, 46, 47, 48, 49, 50, 51, 52, 53, 65, 66, 67, 68, 69, 70, 71, 72 and 75.

With regard to the statements that "Examiner did not indicate allowance subject matter since the Examiner could not find any allowance matter to indicate" and "Examiner provided the columns and paragraph lines where the prior art provides the

teaching", the first statement declares a conclusion and the second statement declares an assertion of fact.

As the record clearly shows, the Office action did not provide references in terms of column numbers and line numbers asserting where each and every feature of claims 1, 4-53 and 65-75 are disclosed in Murphy. Therefore, the Office only provided several references in the prior art but not overwhelming majority of the features recited in the claims. The Applicant has reviewed Murphy in detail and simply cannot find most claimed features of the present invention disclosed therein Murphy. Without having disclosed the claim features of the present invention in Murphy, it is not understood how the Office can reach a conclusion that claims 1, 4-53 and 65-75 are anticipated by Murphy.

Perhaps a review of an important case law regarding what would constitute an anticipation rejection is needed. In this regard, it is well settled by the Federal Circuit that:

"A claim is anticipated only if each and every element *as set forth in the claim* is found, either expressly or inherently described, in a single prior art reference." *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1567, 7 USPQ2d 1057 (Fed. Cir. 1988).

Therefore, in accordance to the Federal Circuit, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a

single prior art reference. Conversely, if each and every element as set forth in the claim is not found, either expressly or inherently described, in a single prior art reference, the claim is not anticipated. With so many claimed features in claims 1, 4-53 and 65-75 not disclosed in Murphy, by operation of law under 35 U.S.C. 102, all of these claims contain allowable subject matter.

With regard to the statement that "Applicant, if he could not find the teachings in the indicated part of the disclosure, need to state the features that are not taught by the prior art", the problem is that the Office action never indicated where most features of claims 1, 4-53 and 65-75 are disclosed or taught in the prior art to begin with. This is self-evidenced by the fact that the Office asserted a shot-gun rejection resorting to merely ten lines of explanation in a single paragraph to reject 57 claims occupying approximately 15 typed pages. From reviewing Murphy and the claimed invention as a whole, it is apparent that the Office has difficulty indicating where each feature of claims 1, 4-53 and 65-75 of the claimed invention is disclosed in Murphy, because the simply fact is that most of these claimed features have never been disclosed by Murphy.

By requesting the Applicant to meet the burden of proof that certain claimed features are patentable without first presenting objective evidence indicating where the claimed features are disclosed or taught in the prior art, the Office is reversing the original intent of Congress in designating that the Office has the initial burden to prove unpatentability of claimed features as clearly expressed in 35 U.S.C. §102. Until such time that the Office is able to objectively indicate where all claimed features are disclosed in Murphy, the Office cannot legitimately justify a legal conclusion that the claimed invention is anticipated by Murphy.

**Group III: Claims 4-53 and 65-75 Argued Separately from**

**Independent Claim 1**

**Claim 4**

Further to features of independent claim 1, dependent claim 4 recites features of determining an amount of result in the record. The Office alleges that these features are disclosed in column 10, lines 41-54 of Murphy. Murphy column 10, lines 41-54 has stated in its entirety that:

"Similar calculations are performed for the wind, precipitation probability for the beginning of the game, then the process is repeated for the time representative of the end of the game. The user ID is also used to retrieved data from the User Preferences Database 412 that identifies the format of the content that is returned to the user. For example, the requesting user can be connected over a high bandwidth

communication connection and the Event Forecast Process 401 can then present the information to the user in a graphically intensive display. Similarly, the user can desire only a subset of the normally presented information, and this "filter factor" can be recorded in the User Preferences Database 412 as a result of prior user activity. Summary"

Therefore, this section of Murphy is predominately concerned with calculation, identify format, user preference and prior user activity. There is no disclosure of specifically determining an amount of result in the record. Applicant also cannot find these features from Murphy.

#### **Claim 5**

Further to features of independent claim 75, dependent claim 5 recites that wherein a utility analyzes behaviors of a requester making the request in view of the record (i.e. Figure 10, reference numeral 1020, page 11, lines 9-20, the paragraph bridging between pages 29 and 30 of the written specification). The Office alleged that these features are disclosed in Murphy Figure 5B, reference numerals 505-506, but the Applicant simply cannot find them in Figure 5B of Murphy. A determination by the Board whether Figure 5B objectively disclosed the claimed features is respectfully requested.

#### **Claim 6**



Further to features of independent claim 1, dependent claim 6 recites determining an actual duration the request stayed active (i.e. page 9, line 18 of the written specification). The Office alleged that these features are disclosed in Murphy Figure 5B, reference numerals 505-506, but the Applicant simply cannot find them in Figure 5B of Murphy. A determination by the Board whether Figure 5B objectively disclosed the claimed features is respectfully requested.

**Claim 7**

Further to features of independent claim 1, dependent claim 7 recites taking an action based on the result obtained from the network in response to the request (i.e. Figure 10, reference 1020). The Office alleged that these features are disclosed in Murphy Figure 5B, reference numerals 505-506, but the Applicant simply cannot find them in Figure 5B of Murphy. Respectfully requested herewith is a determination by the Board regarding whether Figure 5B of Murphy objectively discloses all features claimed further in view of independent claim 1.

There is a fundamental difference between the claimed invention and Murphy. Namely, Murphy is a customized weather forecasting system and the claimed invention is a marketing method of requesting and collecting promotional information to

influence an individual's purchasing decisions. In the context of Murphy, when weather forecasting information conforming to the customized format and need of a user is delivered, the task is considered completed. Murphy is not at all concerned with what actions or inactions the user takes based on the forecasting information. Therefore, it does not collect any information regarding the user after delivering the forecasting information. In the example given in column 8, lines 39-46 of Murphy, forecasting information is given to the user in a manner specified by the user. Whether the user attends or not attend the baseball game is not within the control and not of interest to the forecasting system, and the system simply does not require the user to take any actions after receipt of the forecasting information.

In contradistinction, the present invention is a marketing method delivering promotional information to influence a user's purchasing decisions. Whether promotional information delivered to the user has influenced the user's purchasing decisions is of paramount interest to the marketing method. Therefore, the marketing method would collect and categorize the action taken after delivery of the information to the user.

**Claim 8**

Further to features of dependent claim 7, dependent claim 8 recites categorizing the action taken after receipt of the results (i.e. Figure 10, reference 1020, page 11, lines 7-20). The Office did not specifically mentioned this feature in the rejection. Therefore, no support of where it is disclosed in Murphy is given. Respectfully requested herewith is a determination by the Board regarding whether Murphy objectively disclosed all features claimed further in view of independent claim 1.

There is a fundamental difference between the claimed invention and Murphy. Namely, Murphy is a customized weather forecasting system and the claimed invention is a marketing method of requesting and collecting promotional information to influence an individual's purchasing decisions. In the context of Murphy, when weather forecasting information conforming to the customized format and need of a user is delivered, the task is considered completed. Murphy is not at all concerned with what actions or inactions the user takes based on the forecasting information. Therefore, it does not collect any information regarding the user after delivery of the forecasting information. In the example given in column 8, lines 39-46 of Murphy, forecasting information is given to the user in a manner

specified by the user. Whether the user attends or not attend the baseball game is not within the control and not of interest to the forecasting system, and the system simply does not require the user to take any actions after receipt of the forecasting information.

In contradistinction, the present invention is a marketing method delivering promotional information to influence a user's purchasing decisions. Whether promotional information delivered to the user has influenced the user's purchasing decisions is of paramount interest to the marketing method. Therefore, the marketing method would collect and categorize the action taken after delivered of the information to the user.

#### **Claim 9**

Further to features of independent claim 1 and dependent claim 7, dependent claim 9 further recites wherein the action is one of made a purchase, not made a purchase, continued to make the request, modified the request, purchased within a time range and abandoned the request (i.e. claims as originally filed, the paragraph bridging between pages 10 and 11, pages 5-6 of Figure 15).

The Office in finally rejecting the claimed invention has positively asserted that Murphy "teaches user preference

database to record past activity of the user; action is one of made a purchase, not a purchase etc." The Office alleged that these features are fully disclosed in col. 1, line 62 to col. 2, line 61, col. 3 line 40 to col. 4 line 41, col. 7 line 63 to col. 9 line 11 and col. 10 line 55 to col. 11 line 18 and Figure 5A of Murphy.

The Applicant simply cannot find any information regarding an action of making a purchase or not making a purchase in Murphy. In fact, such words as "buy", "payment", "purchase", "credit card", "charge" and "transaction" do not appear in Murphy at all. It is not understood how the Office concludes with such specificity that Murphy discloses features of "make a purchase, not a purchase, etc."

There is a fundamental difference between the claimed invention and Murphy. Namely, Murphy is a customized weather forecasting system and the claimed invention is a marketing method of requesting and collecting promotional information to influence an individual's purchasing decisions. In the context of Murphy, when weather forecasting information conforming to the customized format and need of a user is delivered, the task is considered completed. Murphy is not at all concerned with what actions or inactions the user takes based on the forecasting information. Therefore, it does not collect any

information regarding the user after delivering the forecasting information. In the example given in column 8, lines 39-46 of Murphy, forecasting information is given to the user in a manner specified by the user. Whether the user attends or not attend the baseball game is not within the control and not of interest to the forecasting system, and the system simply does not require the user to take any actions after receipt of the forecasting information. Furthermore, after delivery of the forecasted weather information, it is not understood in the opinion of the Office as supported by Murphy, what is there to purchase?

In contradistinction, the present invention is a marketing method delivering promotional information to influence a user's purchasing decisions. Whether promotional information delivered to the user has influenced the user's purchasing decisions is of paramount interest to the marketing method. Therefore, the marketing method would collect and categorize the action taken after delivery of the information to the user.

Respectfully requested herewith is a determination by the Board regarding whether all features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 10**

Further to features of independent claim 1, dependent claim 10 recites inputting information associated with one of various levels of readiness to buy and a purchase intentionality index (i.e. page 18 of Figure 15, page 4 of Figure 16).

The Office merely rejected claim 10 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 11**

Further to features of independent claim 1, dependent claim 11 recites entering information associated with a usage intentionality index (i.e. claims as originally filed, page 5 of Figure 15).

The Office merely rejected claim 11 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 12**

Further to features of independent claim 1, dependent claim 12 recites determining whether to issue one of an electronic refund and a coupon voucher based on one of the purchase intentionality status, the purchase intentionality index and the usage intentionality index (i.e. claims as originally filed, page 18 of Figure 15, page 26 of Figure 16).

The Office merely rejected claim 12 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 13**

Further to features of independent claim 1, dependent claim 13 recites specifying one of a destination and a plurality of destinations regarding where a result of the request is to be delivered to (ie, claims as originally filed, Figure 5b, reference numerals 879, 826-845).



The Office merely rejected claim 13 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 14**

Further to features of independent claim 1, dependent claim 14 recites wherein an origin of where the request is initiated from is insulated from the network (i.e. claims as originally filed, pages 4 and 15 of Figure 15, page 22 of Figure 16).

The Office merely rejected claim 14 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 15**

Further to features of independent claim 1, dependent claim 15 recites wherein the request comprises a plurality of request

parameters (i.e. page 51, lines 9-13 of the written specification).

The Office merely rejected claim 15 without providing any information as to where these features are disclosed in Murphy. A determination by the Board whether these features further in view of independent claim 1 are objectively disclosed in Murphy is respectfully requested.

**Claim 16**

Further to features of independent claim 1, dependent claim 16 recites wherein the duration is preset for one of a future activation date and a future cut-off date (i.e. claims as originally filed).

The Office merely rejected claim 16 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 17**

Further to features of independent claim 1, dependent claim 17 recites specifying a time the request is made known to the network (i.e. claims as originally filed, Figure 10).

The Office merely rejected claim 17 without providing any information as to where these features are disclosed in Murphy. A determination by the Board whether these features further in view of independent claim 1 are objectively disclosed in Murphy is respectfully requested.

**Claim 18**

Further to features of independent claim 1, dependent claim 18 recites entering a quantity of information desired as expressed in one of a fixed number and a range (i.e. claims as originally filed, Figure 4, reference numeral 979).

The Office merely rejected claim 18 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 19**

Further to features of independent claim 1, dependent claim 19 recites entering a preferred method of transmission as expressed in a transmission rate (i.e. claims as originally

filed, the paragraph bridging between page 24 and 25 of the written specification, pages 1 and 12 of Figure 16).

The Office merely rejected claim 19 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 20**

Further to features of independent claim 1, dependent claim 20 recites entering a preferred method of transmission suitable for a particular type of receiving terminus (i.e. claims as originally filed, the paragraph bridging between page 24 and 25 of the written specification, pages 1 and 12 of Figure 16).

The Office merely rejected claim 20 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 21**

Further to features of independent claim 1, dependent claim 21 recites entering a geographic region where the type of information is to be collected from (i.e. claims as originally filed, the paragraph bridging between pages 44 and 45).

The Office merely rejected claim 21 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 22**

Further to features of independent claim 1, dependent claim 22 recites specifying a certain promotional type which the type of information is to be collected from (i.e. claims as originally filed, page 12, lines 5-13 of the written specification, page 3 of Figure 15).

The Office merely rejected claim 22 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding

whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 23**

Further to features of independent claim 1, dependent claim 23 recites specifying a source of origin where the type of information is to be collected from (i.e. claims as originally filed, the paragraph bridging between pages 44 and 45 of the written specification).

The Office merely rejected claim 23 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 24**

Further to features of independent claim 1, dependent claim 24 recites specifying the type of information must be collected from a source accepting a certain transaction method (i.e. claims as originally filed).

The Office merely rejected claim 24 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 25**

Further to features of independent claim 1, dependent claim 25 recites entering a delivery priority of the type of information based on a plurality of terminus (i.e. claims as originally filed, pages 3-4, 9, 12 of Figure 16).

The Office merely rejected claim 25 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 26**

Further to features of independent claim 1 and dependent claim 15, dependent claim 26 recites ranking a plurality of results based on how close each result matches the plurality of

request parameters (i.e. claims as originally filed, pages 4 and 12 of Figure 16).

The Office merely rejected claim 26 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

#### **Claim 27**

Further to features of independent claim 1 and dependent claim 15, dependent claim 27 recites entering a priority of delivery based on how well a plurality of results matches the specified request parameters (i.e. claims as originally filed, page 3-4 of Figure 15, pages 12 and 17 of Figure 16).

The Office merely rejected claim 27 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 and dependent claim 15 are objectively disclosed in Murphy.



**Claim 28**

Further to features of independent claim 1, dependent claim 28 recites specifying a time the type of information should be delivered to the information account (i.e. claims as originally filed, page 17 of Figure 15).

The Office merely rejected claim 28 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 29**

Further to features of independent claim 1, dependent claim 29 recites specifying a repetitive pattern the type of information should be delivered to the information account (i.e. claims as originally filed, pages 3 and 17 of Figure 15).

The Office merely rejected claim 29 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding

whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 30**

Further to features of independent claim 1, dependent claim 30 recites determining whether to issue wherein the account comprises an electronic mail (email) account, an instant messaging account, a wireless short messaging account, a wireless account, a cellular telephone account, a paging account, a facsimile number, a voice mailbox, a bulletin board, an addressable TV terminus address, a posting address and a print out address (i.e. claim as originally filed, pages 1 and 4 of Figure 15).

The Office merely rejected claim 30 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 31**

Further to features of independent claim 1, dependent claim 31 recites wherein the type of information is indicated by one of selecting from an index with a mouse, entering from a

keyboard and entering orally with a microphone (i.e. claims as originally filed).

The Office merely rejected claim 31 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 32**

Further to features of independent claim 1, dependent claim 32 recites wherein the type of information is searched from one of a public domain resource and a private domain resource (i.e. claims as originally filed).

The Office merely rejected claim 32 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 33**

Further to features of independent claim 1, dependent claim 33 recites wherein the duration is measured in one of seconds, minutes, hours, days, weeks, months, years, and a combination thereof (i.e. claims as originally filed, page 12, lines 5-13 of the written specification.)

The Office merely rejected claim 33 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 34**

Further to features of independent claim 1, dependent claim 34 recites entering an update interval of the request (i.e. claims as originally filed, the paragraph bridging between pages 40 and 41 and the paragraph bridging between pages 44 and 45 of the written specification).

The Office merely rejected claim 34 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding

whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 35**

Further to features of independent claim 1 and dependent claim 34, dependent claim 35 recites wherein the update interval is measured in one of seconds, minutes, hours, days, weeks, months, years, and a combination thereof (claims as originally filed).

The Office merely rejected claim 35 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 36**

Further to features of independent claim 1, dependent claim 36 recites specifying a format of a result (i.e. claims as originally filed, page 41, line 14 to page 42, line 9 of the written specification).

The Office merely rejected claim 36 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully

requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 37**

Further to features of independent claim 1 and dependent claim 36, dependent claim 37 recites wherein the format comprises HTML/PIX, Video, Audio, Text, ASCII, TIFF, JPEG and other formats used in the digital transmission of data (i.e. claims as originally filed, page 41, line 14 to page 42, line 9 of the written specification).

The Office merely rejected claim 37 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 and dependent claim 36 are objectively disclosed in Murphy.

**Claim 38**

Further to features of independent claim 1, dependent claim 38 recites specifying whether a related subject of the type of information is desired (i.e. claims as originally filed, page 14, line 13 of the written specification).

The Office merely rejected claim 38 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 39**

Further to features of independent claim 1, dependent claim 39 recites specifying whether a search should be conducted in one of a public domain resource, a private domain resource, and a combination thereof (i.e. claims as originally filed).

The Office merely rejected claim 39 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 40**

Further to features of independent claim 1 and dependent claim 39, dependent claim 40 recites taking payment information from a requester via one of a micro-payment system, billing or credit card system (i.e. claims as originally filed, the

paragraph bridging between pages 10 and 11 of the written specification).

The Office merely rejected claim 40 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 and dependent claim 39 are objectively disclosed in Murphy.

**Claim 41**

Further to features of independent claim 1, dependent claim 41 recites receiving a result of the requested type of information in the account in a specified format at a specified update interval within the duration the request is active, in a quantity desired and according to a priority and a preference (i.e. claims as originally filed).

The Office merely rejected claim 41 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.



**Claim 42**

Further to features of independent claim 1, dependent claim 42 recites wherein the method is implemented on one of an instant messaging utility, a wireless messaging utility (WAP or other), an electronic mail utility, a paging utility, a facsimile utility, a voice mail utility, a bulletin board utility, a printer utility, a browser utility, a cable utility, a satellite utility, a digital broadcast utility, a television system utility, a web-TV utility and an Internet utility (i.e. claims as originally filed).

The Office merely rejected claim 42 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 43**

Further to features of independent claim 1, dependent claim 43 recites wherein the request is transmitted via one of a 2-way addressable television system, or a hybrid system where download is via a broadband signal and upload is via telephone, a cable system, an Internet system, an Intranet system, a satellite

system, a Web-TV system and a digital broadcast system, a local area network and a wide area network (i.e. claims as originally filed).

The Office merely rejected claim 43 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 44**

Further to features of independent claim 1, dependent claim 44 recites wherein the method is implemented on a computer system in one of an always active mode and a launched upon request mode (i.e. claims as originally filed, the paragraph bridging between pages 44 and 45 of the written specification).

The Office merely rejected claim 44 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 45**

Further to features of independent claim 1, dependent claim 45 recites wherein the method is integrated as a request utility as part of one of a web site and a portal (i.e. claims as originally filed, the paragraph bridging between pages 24 and 25 of the written specification).

The Office merely rejected claim 45 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 46**

Further to features of independent claim 1, dependent claim 46 recites wherein a requester's identity is concealed from an origin providing a result relevant to the request (i.e. claims as originally filed, page 4 of Figure 15).

The Office merely rejected claim 46 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding

whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 47**

Further to features of independent claim 1, dependent claim 47 recites designating automatic forwarding of requested informational/advertising e-mails to one of a single party, a plurality of parties, an existing carbon copy (cc) list, and a newly created distribution list of e-mail recipients (i.e. claims as originally filed, page 9, lines 15-23 of the written specification).

The Office merely rejected claim 47 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 48**

Further to features of independent claim 1, dependent claim 48 recites paying for a result relevant to the request by one of a micro-payment, billing, and credit card system (i.e. claims as originally filed, the paragraph bridging pages 10-11 of the written specification).

The Office merely rejected claim 48 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 49**

Further to features of independent claim 1, dependent claim 49 recites wherein the system captures a requester behavior with respect to a result delivered to the requester (i.e. claims as originally filed, pages 5-7 of Figure 15).

The Office merely rejected claim 49 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 50**

Further to features of independent claim 1 and dependent claim 49, dependent claim 50 recites wherein the requester behavior comprises opening the result, saving the result,

deleting the result, forwarding the result, responding to the result, making a purchase transaction via email in response to the result, registering for any offer in response to the result and archiving the result (i.e. claims as originally filed, page 5, 8 and 14 of Figure 16).

The Office merely rejected claim 50 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 and dependent claim 49 are objectively disclosed in Murphy.

#### **Claim 51**

Further to features of independent claim 1, dependent claim 51 recites wherein should the request fail to specify any preferences or request criteria, default preferences or request criteria are imposed by the system (i.e. claims as originally filed, the paragraph bridging between pages 40 and 42 of the written specification).

The Office merely rejected claim 51 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully

requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 52**

Further to features of independent claim 1 and dependent claim 51, dependent claim 52 recites wherein the default preferences or request criteria are based on one of an average preferences or request criteria of the account in the type of information, an average preferences or request criteria of the overall account, an average preferences or request criteria of the system in the type of information, and an average preferences or request criteria of the overall system (i.e. claims as originally filed, the paragraph bridging between pages 40 and 42 of the written specification).

The Office merely rejected claim 52 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 and dependent claim 52 are objectively disclosed in Murphy.

**Claim 53**

Further to features of independent claim 1, dependent claim 53 recites wherein a result of the request can only reach the account with one of a digital key, a certificate for permitted access and a password recognized by a lookup table (i.e. claims as originally filed, pages 1, 11 and 16 of Figure 15).

The Office merely rejected claim 53 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 65**

Further to features of independent claim 1, dependent claim 65 recites wherein the requesting and collecting of information is performed by being one of a trusted intermediary and a third party (i.e. page 16, lines 9-21 of the written specification).

The Office merely rejected claim 65 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully



requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 66**

Further to features of independent claim 1 and dependent claim 65, dependent claim 66 recites wherein a feature of one of the trusted intermediary and third party is achieved by having the processor and the memory to hold a lookup table (i.e. claim 53 as originally filed).

The Office merely rejected claim 66 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 and dependent claim 65 are objectively disclosed in Murphy.

**Claim 67**

Further to features of independent claim 1 and dependent claim 65, dependent claim 67 recites wherein a feature of one of the trusted intermediary and third party is achieved by a channelized address (i.e. pages 2 and 6 of Figure 16).

The Office merely rejected claim 67 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Claim 68**

Further to features of independent claim 1 and dependent claim 65 dependent claim 68 recites wherein a feature of the trusted intermediary and the third party is achieved by a limited used cryptographic system (claim 53 as originally filed).

The Office merely rejected claim 68 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 and dependent claim 65 are objectively disclosed in Murphy.

**Claim 69**

Further to features of independent claim 1 and dependent claim 65, dependent claim 69 recites wherein a feature of one of the trusted intermediary and the third party is achieved by a traditional email alias account wherein the aliases are deleted from the account once a predetermined time has expired.

The Office merely rejected claim 69 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 and dependent claim 65 are objectively disclosed in Murphy.

#### **Claim 70**

Further to features of independent claim 1 and dependent claim 65, dependent claim 70 recites wherein a feature of one of the trusted intermediary and the third party is achieved by storing a computer table in a relational database (pages 1, 11 and 16 of Figure 15).

The Office merely rejected claim 70 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding

whether these features claimed further in view of independent claim 1 and dependent claim 65 are objectively disclosed in Murphy.

**Claim 71**

Further to features of independent claim 1 and dependent claims 65-66, dependent claim 71 recites wherein the lookup table is held by a bonded party to insulate a seeking party and a providing party from knowing each other (i.e. originally filed claims 14 & 46, page 16, lines 9-21).

The Office merely rejected claim 71 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 and dependent claims 65-66 are objectively disclosed in Murphy.

**Claim 72**

Further to features of independent claim 1 and dependent claim 65, dependent claim 72 recites wherein a feature of one of the trusted intermediary and the third party is achieved by insulating a purchasing party and a selling party from knowing

each other after consummation of a sales transaction (i.e. originally filed claim 14, page 16, lines 9-21).

The Office merely rejected claim 72 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 and dependent claims 65-66 are objectively disclosed in Murphy.

**Claim 73**

Independent claim 73 is derived by incorporating the subject matter of independent claim 1 and some subject matter of dependent claim 10.

The Office merely rejected claim 73 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features are objectively disclosed in Murphy.

**Claim 74**

Independent claim 74 is derived by incorporating the subject matter of independent claim 1 and some subject matter of dependent claim 10.

The Office merely rejected claim 74 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features are objectively disclosed in Murphy.

**Claim 75**

The subject matter of claim 75 is the same as previously canceled claim 3.

The Office merely rejected claim 74 without providing any information as to where these features are disclosed in Murphy. The Applicant also cannot find them in Murphy. Respectfully requested herewith is a determination by the Board regarding whether these features claimed further in view of independent claim 1 are objectively disclosed in Murphy.

**Group II: Rejection under 35 USC §103(a), Obviousness**

Whether claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable by Murphy further in view of Chern et al. (U.S. Patent No. 6,381,465).

In the final Office action, the Office has specifically stated that "[r]egarding claim 12, Murphy does not teach determining whether to issue electronic refund or coupon". The Applicant agrees with this Office assessed shortcoming of Murphy.

However, this is not the only shortcoming of Murphy. Murphy also fails to disclose or teach a marketing method of requesting and collecting promotional information to influence an individual's purchasing decisions comprising of specific steps of requesting the promotional information, entering a duration in which the request is active, collecting the promotional information and storing the promotional information.

Claim 12 of the present invention has specifically stated in relevant part "determining whether to issue one of an electronic refund and a coupon voucher based on one of the purchase intentionality status, the purchased intentionality index and the usage intentionality index." Therefore, the determination whether to issue an electronic refund or a coupon voucher depends on either a purchase intentionality status, a purchase intentionality index or a usage intentionality index. In the rejection asserted by the Office based on Murphy and Chern et al., the Office never indicated where in Murphy or Chern et al. is there any disclosure of a purchase

intentionality status, a purchase intentionality index or a usage intentionality index. The Applicant also cannot find any of these features in Murphy or Chern et al.

In rejecting claim 12, the Office merely mentioned electronic coupon or coupon voucher allegedly taught in Figures 15-17 and column 13, lines 36-64 of Chern. The Office specifically stated that:

"Chern teaches alert message with advertising in order inform the consumer of promotion (see col. 13 lines 36-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to combine Murphy's event notifier with Chern's alert message with advertisement for the purpose of enticing consumer to take advantage of the promotional activity."

In this rejection, the Office completely ignored a purchase intentionality status, a purchase intentionality index or a usage intentionality index upon which the electronic coupon or coupon voucher depend. These features have been specifically recited in the claim language. As to column 13 lines 36-64 of Chern where the Office alledged to have disclosed or taught an electronic coupon or coupon voucher, it is simply not true. Column 13 lines 36-64 of Chern states in its entirety that:

"Server 858 may be a part of an Internet web site, and includes an alert server 852, an agent server 854, and an ad server 856. When server 858 receives monitoring request 851, agent server 854 monitors appropriate databases, Internet web sites, and other sources of information, which may include other agents, for the occurrence of conditions that



would meet the user's request. When the conditions are met, agent server 854 generates an SMS alert message and requests ad server 856 to append any advertising. Based on the alert message content, user location and preferences, and available ad space, an ad message is generated by server 856 and appended to the alert message. Alert server 852 then sends the alert message with appended advertising (859) to the user's handset 859.

FIG. 16 shows examples of alert messages and appended ad messages on wireless handset displays 860 and 870. In this example, the user has sent a monitoring request to the server requesting to be alerted if changes occur with her itinerary. The server has determined that the user's flight has been delayed from 3:30 PM to 4:15 PM, and generates appropriate alert messages 862, 872. Based on the user's profile (i.e., coffee drinker or frequent flyer program member), the alert message content (flight delay), and the user's location (airport or nearby), the ad server generates an appropriate ad message that is appended to the alert message. Ad message 864, for example, notifies the user of a coffee promotion in the airport. Ad message 874 notifies the user of a frequent flyer promotion in the airport."

In this explanation of Chern, should a user sent a monitoring request to inquire possible schedule changes, an alert message may be generated if there is a delay to a schedule and a message of coffee promotion at the airport may be communicated to the user via wireless messaging.

It should be noted that an electronic coupon or a coupon voucher is somewhat like a negotiable instrument but differentiated therefrom in that upon presentment of which, instead of receiving a specified cash value stated thereon the coupon, the tenderor receives a discount of cash value

equivalent to the amount stated thereon the coupon in purchasing a good or service. The critical issue is that there must be a presentment of an instrument to receive the benefit of a cost reduction.

In contradistinction, a promotion may not require presentment of any instrument. A promotion may merely require a person to make a purchase within a specified period of time or be of a certain designated status to receive either a cost reduction or receive goods or services with a market value higher than the amount paid. In the context given in the written specification of Chern, it would be understood by a person of ordinary skill in the art that a wireless emessage is ordinarily not used as a valid presentment of an instrument at a coffee shop at airports. This understanding is further reinforced by the written specification clearly stating that the wireless emessage merely "notifies the user of a coffee promotion in the airport. Ad message 874 notifies the user of a frequent flyer promotion in the airport." Twice in succession the written specification repeatedly emphasizes that the wireless message provides notifications of promotions, not distribution of coupons. They are not the same and should not be mistakenly regarded as the same.

This is an example of the piecemeal and out of context nature the Office has examined the instant application. Regarding piecemeal examination, section 707.07(g) of the MPEP has specifically stated that:

"Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references. (See MPEP § 904.03.) ... Where a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression."

In rejecting claim 12 of the present invention, the Office certainly did not provide a full development of reasons. In fact, the Office ignored specifically recited claimed elements and their inter-relationship with other claimed elements, mistakenly equated a notification of promotion as a distribution of coupon that can be used for presentment purposes, then provided a pre-matured conclusion coupled with some stereotyped expressions.

Section 706.01(j) of the MPEP has specifically stated that:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found

in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 466, 20 USPQ2d 1438 (Fed. Cir. 1991)"

Therefore, it is the position of the Federal Circuit and the U.S. Patent & Trademark Office that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure

In the instant application, the Office has not established a *prima facie* case of obviousness, because, 1) the claimed features of purchase intentionality status, the purchase intentionality index or the usage intentionality index are not disclosed or taught in Murphy or Chern et al., 2) there is not any suggestion or teaching as to how the weather predicting system of Murphy can be combined with the advertisement system for wireless transmission of Chern et al. in a way that would provide any reasonable expectation of success, 3) the Office has

not communicated where the claim limitations of claims 1 and 12 are disclosed or suggested in Murphy and Chern et al.

For the foregoing reasons, based on the very standards established by the Federal Circuit and adopted by the U.S. Patent & Trademark Office, a *prima facie* case of obviousness is not met in this case. Even if Murphy and Chern et al. are combined exactly as suggested in the final Office action, the claimed invention would not result.

**Conclusion**

In accordance with the foregoing, it is submitted that the claimed invention is patentably distinguished over the applied prior art of record and the rejection of all pending claims is erroneous. Therefore, a reversal of all rejections applied to the instant application is respectfully requested.

**(8) Claim Appendix**

1. (Amended) A marketing method of requesting and collecting promotional information to influence an individual's purchasing decisions from a network via an information account of a system with a processor and a memory, comprising a plurality of steps of:

making a request by indicating to the information account a type of information desired;

entering a duration in which the request is active;

collecting in the information account a result obtained from the network in response to the request, within the duration;

storing in the memory both the request and the result.

2. (Canceled) The method of claim 1, further comprising a step of:

receiving in the information account a result obtained from the network in response to the request.

3. (Canceled) The method of claim 1, further comprising a step of:

maintaining a record to capture the request and a result obtained from the network in response to the request.

4. (Amended) The method of claim [1] 75, further comprising a step of:

determining an amount of result in the record.

5. (Amended) The method of claim [1] 75, wherein a utility analyzes behaviors of a requester making the request in view of the record.

6. (Original) The method of claim 1, further comprising a step of:

determining an actual duration the request stayed active.

7. (Original) The method of claim 1, further comprising a step of:

taking an action based on the result obtained from the network in response to the request.

8. (Original) The method of claim 7, further comprising a step of:

categorizing the action taken after receipt of the results.



9. (Original) The method of claim 7, wherein the action is one of made a purchase, not made a purchase, continued to make the request, modified the request, purchased within a time range and abandoned the request.

10. (Amended) The method of claim 1, further comprising a step of:

inputting information associated with one of various levels of readiness to buy and a purchase intentionality index.

11. (Amended) The method of claim 1, further comprising a step of:

entering information associated with a usage intentionality index.

12. (Original) The method of claim 11, further comprising a step of:

determining whether to issue one of an electronic refund and a coupon voucher based on one of the purchase intentionality status, the purchase intentionality index and the usage intentionality index.

13. (Original) The method of claim 1, further comprising a step of:

specifying one of a destination and a plurality of destinations regarding where a result of the request is to be delivered to.

14. (Original) The method of claim 1, wherein an origin of where the request is initiated from is insulated from the network.

15. (Original) The method of claim 1, wherein the request comprises a plurality of request parameters.

16. (Original) The method of claim 1, wherein the duration is preset for one of a future activation date and a future cut-off date.

17. (Original) The method of claim 1, further comprising a step of:

specifying a time the request is made known to the network.

18. (Original) The method of claim 1, further comprising a step of:

entering a quantity of information desired as expressed in one of a fixed number and a range.

19. (Original) The method of claim 1, further comprising a step of:

entering a preferred method of transmission as expressed in a transmission rate.

20. (Original) The method of claim 1, further comprising a step of:

entering a preferred method of transmission suitable for a particular type of receiving terminus.

21. (Original) The method of claim 1, further comprising a step of:

entering a geographic region where the type of information is to be collected from.

22. (Original) The method of claim 1, further comprising a step of:

specifying a certain promotional type which the type of information is to be collected from.

23. (Original) The method of claim 1, further comprising a step of:

specifying a source of origin where the type of information is to be collected from.

24. (Original) The method of claim 1, further comprising a step of:

specifying the type of information must be collected from a source accepting a certain transaction method.

25. (Original) The method of claim 1, further comprising a step of:

entering a delivery priority of the type of information based on a plurality of terminus.

26. (Original) The method of claim 15, further comprising a step of:

ranking a plurality of results based on how close each result matches the plurality of request parameters.

27. (Original) The method of claim 15, further comprising a step of:

entering a priority of delivery based on how well a plurality of results matches the specified request parameters.

28. (Original) The method of claim 1, further comprising a step of:

specifying a time the type of information should be delivered to the information account.

29. (Original) The method of claim 1, further comprising a step of:

specifying a repetitive pattern the type of information should be delivered to the information account.

30. (Original) The method of claim 1, wherein the account comprises an electronic mail (email) account, an instant messaging account, a wireless short messaging account, a wireless account, a cellular telephone account, a paging account, a facsimile number, a voice mailbox, a bulletin board, an addressable TV terminus address, a posting address and a print out address.

31. (Original) The method of claim 1, wherein the type of information is indicated by one of selecting from an index with

a mouse, entering from a keyboard and entering orally with a microphone.

32. (Original) The method of claim 1, wherein the type of information is searched from one of a public domain resource and a private domain resource.

33. (Original) The method of claim 1, wherein the duration is measured in one of seconds, minutes, hours, days, weeks, months, years, and a combination thereof.

34. (Original) The method of claim 1, further comprising a step of:

entering an update interval of the request.

35. (Original) The method of claim 34, wherein the update interval is measured in one of seconds, minutes, hours, days, weeks, months, years, and a combination thereof.

36. (Original) The method of claim 1, further comprising a step of:

specifying a format of a result.

37. (Original) The method of claim 36, wherein the format comprises HTML/PIX, Video, Audio, Text, ASCII, TIFF, JPEG and other formats used in the digital transmission of data.

38. (Original) The method of claim 1, further comprising a step of:

specifying whether a related subject of the type of information is desired

39. (Previously Amended) The method of claim 1, further comprising a step of:

specifying whether a search should be conducted in one of a public domain resource, a private domain resource, and a combination thereof.

40. (Original) The method of claim 39, further comprising a step of:

taking payment information from a requester via one of a micro-payment system, billing or credit card system.

41. (Original) The method of claim 1, further comprising a step of:

receiving a result of the requested type of information in the account in a specified format at a specified update interval within the duration the request is active, in a quantity desired and according to a priority and a preference.

42. (Original) The method of claim 1, wherein the method is implemented on one of an instant messaging utility, a wireless messaging utility (WAP or other), an electronic mail utility, a paging utility, a facsimile utility, a voice mail utility, a bulletin board utility, a printer utility, a browser utility, a cable utility, a satellite utility, a digital broadcast utility, a television system utility, a web-TV utility and an Internet utility.

43. (Original) The method of claim 1, wherein the request is transmitted via one of a 2-way addressable television system, or a hybrid system where download is via a broadband signal and upload is via telephone, a cable system, an Internet system, an Intranet system, a satellite system, a Web-TV system and a digital broadcast system, a local area network and a wide area network.



44. (Original) The method of claim 1, wherein the method is implemented on a computer system in one of an always active mode and a launched upon request mode.

45. (Original) The method of claim 1, wherein the method is integrated as a request utility as part of one of a web site and a portal.

46. (Original) The method of claim 1, wherein a requester's identity is concealed from an origin providing a result relevant to the request.

47. (Original) The method of claim 1, further comprising a step of:

designating automatic forwarding of requested informational/advertising e-mails to one of a single party, a plurality of parties, an existing carbon copy (cc) list, and a newly created distribution list of e-mail recipients.

48. (Original) The method of claim 1, further comprising a step of:

paying for a result relevant to the request by one of a micro-payment, billing, and credit card system.

49. (Original) The method of claim 1, wherein the system captures a requester behavior with respect to a result delivered to the requester.

50. (Original) The method of claim 49, wherein the requester behavior comprises opening the result, saving the result, deleting the result, forwarding the result, responding to the result, making a purchase transaction via email in response to the result, registering for any offer in response to the result and archiving the result.

51. (Original) The method of claim 1, wherein should the request fail to specify any preferences or request criteria, default preferences or request criteria are imposed by the system.

52. (Original) The method of claim 51, wherein the default preferences or request criteria are based on one of an average preferences or request criteria of the account in the type of information, an average preferences or request criteria of the overall account, an average preferences or request criteria of

the system in the type of information, and an average preferences or request criteria of the overall system.

53. (Original) The method of claim 1, wherein a result of the request can only reach the account with one of a digital key, a certificate for permitted access and a password recognized by a lookup table.

54. (Withdrawn) A communication system, comprising:

- a subscriber system;
- a supplier system;
- an information memory system;
- an information exchange system;
- a clearinghouse system; and
- a network;

wherein the subscriber system, the supplier system, the information memory system, the information exchange system; the clearinghouse system are interconnected through the network.

55. (Withdrawn) The communication system of claim 54, wherein data of the system are intercommunicated among the subscriber system, the supplier system, the information memory system, the

information exchange system, the clearinghouse system and the network.

56. (Withdrawn) The communication system of claim 54, wherein a subscriber account communicatively connected to the subscriber system makes a request of information having a specified characteristic to the subscriber system.

57. (Withdrawn) The communication system of claim 56, wherein a supplier account communicatively connected to the supplier system provides a supply of information having an indicated characteristic.

58. (Withdrawn) The communication system of claim 57, wherein the information exchange system upon finding a match between the specified characteristic and the indicated characteristic, causes the communication system to transfer the supplied information to the subscriber account.

59. (Withdrawn) The communication system of claim 58, wherein the information exchange system informs the clearinghouse system that the request of information has been fulfilled.

60. (Withdrawn) The communication system of claim 59, wherein the clearinghouse system registers a charge against the subscriber account.

61. (Withdrawn) The communication system of claim 54, wherein the network is one of a local area network, a wide area network or an Internet.

62. (Withdrawn) The communication system of claim 58, wherein the match is one of an exact match and a varying degree of match.

63. (Withdrawn) The communication system of claim 56, wherein the request of information having the specified characteristic is communicated to a plurality of supplier correspondingly having a plurality of supplier accounts communicatively connected to the supplier system.

64. (Withdrawn) A communication system, comprising:  
a dynamic request data system is communicatively connected to an Internet;

an information control panel is communicatively connected to the dynamic request data system;

an email account is communicatively connected to the dynamic request data system;

an information supplier system is communicatively connected to the dynamic request data system;

wherein the dynamic request data system upon receiving a request via the information control panel, initiates a search in one of the internet and the information supplier system and delivers information fulfilling the request to the email account.

65. (previously presented) The method of claim 1, wherein the requesting and collecting of information is performed by being one of a trusted intermediary and a third party.

66. (previously presented) The method of claim 65, wherein a feature of one of the trusted intermediary and third party is achieved by having the processor and the memory to hold a lookup table.

67. (previously presented) The method of claim 65, wherein a feature of one of the trusted intermediary and third party is achieved by a channelized address.

68. (previously presented) The method of claim 65, wherein a feature of the trusted intermediary and the third party is achieved by a limited used cryptographic system.

69 (Amended) The method of claim 1 65, wherein a feature of one of the trusted intermediary and the third party is achieved by a traditional email alias account wherein the aliases are deleted from the account once a predetermined time has expired.

70. (Previously presented) The method of claim 65, wherein a feature of one of the trusted intermediary and the third party is achieved by storing a computer table in a relational database.

71. (Previously presented) The method of claim 66, wherein the lookup table is held by a bonded party to insulate a seeking party and a providing party from knowing each other.

72. (Previously presented) The method of claim 65, wherein a feature of one of the trusted intermediary and the third party is achieved by insulating a purchasing party and a selling party from knowing each other after consummation of a sales transaction.

73. (New) A method of requesting and collecting information from a network via an information account of a system with a processor and a memory, comprising a plurality of steps of:

making a request by indicating to the information account a type of information desired;

entering a duration in which the request is active;  
inputting an information indicative of a level of readiness to buy;

collecting in the information account a result obtained from the network in response to the request, within the duration;

storing in the memory both the request and the result.

74. (New) A method of requesting and collecting information from a network via an information account of a system with a processor and a memory, comprising a plurality of steps of:  
making a request by indicating to the information account a type of information desired;

entering a duration in which the request is active;  
inputting an information indicative of a purchase intentionality;



collecting in the information account a result obtained from the network in response to the request, within the duration;

storing in the memory both the request and the result.

75. (New) The method of claim 1, further comprising a step of: maintaining a record to capture the request and a result obtained from the network in response to the request.

(9) **Evidence Appendix**

There are no copies of any evidence submitted pursuant to §§ 1.130, 1.131 or 1.132 of this title or of any other evidence entered by the Examiner and relied upon by appellant in the appeal.

**(10) Related Proceedings Appendix**

There are no related decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of 37 CFR 41.37.

(11) Table of Authority

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